REMARKS

1. The Amendments, the Support Therefor, and Basis for Entry

No claims have been canceled or added, and claims 1, 7, and 23 have been amended to leave claims 1, 4-7, 10-12, 14-16, 18-20, and 23 in the application. No new matter has been added by the amendments, wherein claims 1, 7, and 23 have been amended (1) to address the §101 and §112 issues noted in Sections 3, 4 and 5 of this Response (below), and (2) to specify in claims 7 and 23 that the generated standardized email address includes the family name (a feature noted, for example, at page 3 lines 4-10 of the application).

2. Section 6 of the Office Action: Objection to Title

The title is amended as per the Examiner's suggestion.

3. Section 8 of the Office Action: Rejection of Claims 1, 4-6 under 35 USC §101

Claim 1 is amended to affirmatively recite the collecting, creating, etc. steps, and also to clarify that the instructions are encoded in the program of the storage device. The §101 rejections are therefore believed to be traversed. Please note that the text of the rejections is not complete in the Office Action, and thus if the rejections are maintained, kindly provide a clear and complete restatement of the rejections.

4. Sections 9-11 of the Office Action: Rejection of Claims 1, 4-6 under 35 USC §112(1)

Claim 1 has been corrected to recite "instructions" rather than "standardized electronic mail address," and this correction is believed to obviate the §112(1) rejections.

5. Section 12 of the Office Action: Rejection of Claims 1, 4-7, 10-12, 14-16, 18-20, and 23 under 35 USC §112(2)

All §112(2) issues noted in the Office Action are addressed by the amendments to the claims.

6. Sections 3-5 and 13-17 of the Office Action: Rejection of Independent Claims 1, 7, and 23 under 35 USC §103(a) in view of U.S. Patent 5,987,508 to *Agraharam et al.*

6.a. The Differences Between the Claimed Invention and the Prior Art

Before reviewing these rejections in greater detail, it is initially useful to review the teachings of *Agraharam et al.*. *Agraharam* is directed to the problem that email senders often cannot remember a person's email address (see column 1 lines 10-36, column 2 line 66-column 3 line 9). *Agraharam* seeks to bypass this problem by allowing the use of one's telephone number as an email address: by creating an "alias email address" which "consists of the recipient's telephone number as the recipient name at a well-known and publicized common domain name server" (column 1 lines 44-47). Thus, a recipient may register with the provider of the invention and provide his/her telephone number and "primary" email address (column 3 lines 35-41). The invention then creates an alias email address, e.g., [telephone number]@email.[domain], that senders may use if they do not know the recipient's primary email address (column 3 lines 41-50). An example given by the patent is that Steve G., whose telephone number is 201-555-8765 and whose primary email address is steveg@attmail.com, might be assigned the alias email 2015558765@email.att.net after registering and providing his telephone number and whose primary email address.

Column 5 lines 8-23 note that when an alias email such as 2015558765@email.att.net is generated, associated alias emails which include country codes may also be generated, such as 2015558765@email.att.**us**.net, 2015558765@email.att.**uk**.net, 2015558765@email.att.**ca**.net, and so forth. This allows a sender to use an alias email which either does or does not include a country code.

Further, column 5 lines 24-37 note that since multiple people may share the same telephone number, multiple recipients may register with the same telephone number (and with different primary email addresses). In this case, so that emails sent to an alias email address are sent to the correct recipient at his/her correct primary email address, a name may be added to the alias email addresses (such as 2015558765.**steve**@email.att.net) so that the alias email is directed to the desired individual at his/her correct primary email address.

When an email is then sent to an alias email address (e.g., 2015558765@email.att.net), the provider receives it, looks up the primary email address associated with the alias email address (e.g., steveg@attmail.com), and forwards the email on to the recipient's primary email address (column 3 lines 51-66). Where a recipient has not yet registered for the service and a sender sends an email to the alias email address (e.g., 2015558765@email.att.net), the system will not be able to locate the recipient's primary email address, and here the provider might generate an automated voice mail and deliver it to the corresponding telephone number (here 201-555-8765) suggesting that the recipient register for the service (column 4 lines 13-41; see also column 5 line 38 onward). If the recipient does not register, the email can be returned to the sender (column 4 lines 28-41).

Also, registered users are allowed to search for the primary email addresses of other registered users: a registered user may enter the telephone number of an intended recipient, and thereby receive the actual/primary email address of the recipient rather than the alias email (column 6 lines 6-22).

As noted in the prior Response, independent claim 1 is directed to generation of standardized email addresses, and of a searchable database of such addresses. As recited in clause a., name and location data for an individual are sought and collected from an information source. As an example, a "spider" or "robot" may comb websites for name and location data related to individuals. As noted in clause b. of claim 1, if name and location data are found, an entry is created in a database for the individual. This entry may be an "at least partial" entry, i.e., it may contain only rudimentary details on name and location. However, as recited in clause c., once sufficient name and location data are found – once the name data includes a family name (surname), and once the location data includes one or more of a country specific postal address locator code (e.g., a zip code) and/or a region specific portion of a telephone number (e.g., an area code) – a standardized electronic mail address is created. The standardized electronic mail address includes a personal name code indicative of the collected name data of the individual, and a location code indicative of the collected known location data of the individual. The standardized electronic mail address is then added to the database, and

can be searched by the personal name code and location code to return the standardized electronic mail address (clauses d and e). Independent claims 7 and 23 recite similar matter.

Note that in claim 1, a database is first built which includes at least partial name and location data for an individual, and the invention then creates an email address (and adds it to the database) only when the name and location data for the individual is "complete" (i.e., when it includes certain items of name and location data), rather than partial. In other words, the invention builds a collection of standardized electronic mail addresses over time. As information sources are searched for individuals' name and location data, an entry may be created for an individual once name and location data are found, but the entry is not completed – i.e., a standardized electronic mail address is not created and added to the individual's entry – unless and until certain name and location data is finally found (a family name and one or more of postal address locator code and/or a region specific portion of a telephone number).

The claimed invention therefore differs from *Agraharam*, wherein a database of standardized electronic mail addresses is created, but each entry and standardized electronic mail address in the *Agraharam* database is created *immediately* once a user registers for the system (which requires that the user provide their telephone number and primary email address; see column 3 lines 35-41 and column 5 lines 49-52). *Agraharam* therefore requires registration – that each user "opt in" and provide a telephone number and primary email address – and there is no automatic generation of a database containing at least partial database entries, and subsequent generation of a standardized electronic mail address once certain data (family name, and postal code and/or region-specific portion of telephone number) is collected. Further, the standardized electronic mail addresses created by *Agraharam* are different: they *must* include the entire telephone number – this is *Agraharam*'s main objective, as it its very purpose is to allow emailing by use of knowledge of one's telephone number – and optionally may include a first name and/or country code (e.g., .us, .uk, .ca). Family name (surname) is irrelevant; it does not trigger generation of the *Agraharam* standardized electronic mail address, nor is it used in the *Agraharam* standardized electronic mail address. Similarly, no postal address locator code is used for triggering email address generation, nor is it

used in the *Agraharam* email address, save for as part of the overall telephone number used as the foundation for the *Agraharam* email address.

According to the USPTO's new *Examination Guidelines for Determining Obviousness Under 35 U.S.C. 103 in View of the Supreme Court Decision in KSR International Co. v. Teleflex Inc.*, at 72 Federal Register 57526 (currently available at http://www.uspto.gov/web/offices/com/sol/notices/72fr57526.pdf), any obviousness rejection *must* clearly identify the differences between the claimed invention and the prior art. The foregoing discussion is believed to accurately identify the differences between claim 1 (and 7 and 23) from *Agraharam*. In any subsequent Office Action, for purposes of further Response or appeal, kindly indicate whether the Office agrees whether these are the differences between the claimed invention and *Agraharam*. With respect, the current rejections do not correctly identify the differences between the claimed invention and *Agraharam*, and are confusing because they cite extended passages of *Agraharam* which do not seem to apply to the claim limitations in issue. To illustrate, looking specifically to the rejections of claim 1 (and 7 and 23) at ***page 8*** of the Office Action, it is alleged that *Agraharam et al.* includes:

> instructions operable to create an at least partial entry for the individual in an index of individuals in a database, the at least partial entry being based on the collected name and known location data of the individual (usage of database and alias addressing mechanism, directory, registry, col., 6, lines 6 - 67);

The cited passages of *Agraharam* do not in fact appear to disclose this matter. The cited column 6 lines 6-67 of *Agraharam* discuss the ability of users of the *Agraharam* system to look up the email addresses of other users: a seeking user first enters his/her own telephone number and PIN number to verify that he/she is an authorized user. If the seeking user is an authorized user, the seeking user may enter the telephone number of the user he/she seeks (the sought user), and the *Agraharam* system will then return the sought user's email address (so long as the sought user does not have an unpublished telephone number and email address). Otherwise, the cited column 6 lines 6-67 contain a detailed description of how a PIN number is securely provided to a user.

In contrast, claim 1 recites:

> b. instructions creating an at least partial entry for the individual in an index of individuals in a database, the at least partial entry being created once the name data and the known location data of the individual are collected;

Claims 7 and 23 contain similar recitations. The limitations recited in clause b of claim 1 basically state that a database of individuals is compiled, with at least partial entries being created for each individual once name data and location data are collected for the individual. *Agraharam*, in contrast, creates a database for individuals once telephone number and primary email address are known for an individual: this is all *Agraharam* needs to operate in the manner described at the cited column 6 lines 6-67. *Agraharam* does not in fact disclose or in any way suggest the recited limitations of clause b: why would *Agraharam* be modified to begin constructing database entries once *name and location data* are collected for an individual, given that *Agraharam*'s system relies on *telephone numbers and (primary) email addresses*?

As another illustration, at ***page 8*** of the Office Action, it is further alleged that *Agraharam et al.* includes:

> instructions operable to handle a standardized electronic mail address for the individual once both name and known location data have been collected (e.g., col., l, lines 22 - 57) wherein the name data includes at least the family name of the individual and the location data includes a region specific portion of a telephone number (e.g., col., 5, lines 24 - 58)

Again, the cited passages of *Agraharam* do not in fact appear to disclose this matter. The cited column 1 lines 22-57 of *Agraharam* simply note that conventional email messages take the form of recipient_name@domain_name, and are difficult to use because one cannot send an email to a recipient unless the recipient's email address is properly known/remembered. The cited passage further notes that *Agraharam* addresses this by linking telephone numbers and email addresses, such that users are assigned an "alias" email address – a secondary email address consisting of the user's telephone number – which, when emailed, relays the email to the user's primary email address. Thus, all an email sender needs to know/remember of the email recipient is his/her telephone number. The cited column 5 lines 24-58 of *Agraharam* then note that when multiple users share the same telephone number, the alias email address may be constructed of a telephone number *and* a

name; and further, users will not be able to access the *Agraharam* system unless they sign up for it, and provide their telephone number and primary email address (column 5 lines 49-52, see also column 3 lines 35-41).

In contrast, claim 1 recites:

> c. instructions triggering generation of a standardized electronic mail address for the individual once both the name data and the known location data have been collected wherein:
> (1) the name data includes at least a family name of the individual, and
> (2) the location data includes one or more of
> (a) a country specific postal address locator code,
> (b) a region specific portion of a telephone number,

Claims 7 and 23 contain similar recitations. The limitations recited in clause c of claim 1 basically state that once at least a family name *and* either (a) a postal address locator code (e.g., a zip code) or (b) a region specific portion of a telephone number (e.g., a telephone area code) is collected, a standardized electronic mail address will then be created. *Agraharam*, again, creates an alias email from one's telephone number (and possibly from a portion of one's name, and/or from one's country, column 5 lines 8-37) once a user enters their telephone number and primary email address (column 5 lines 49-52, see also column 3 lines 35-41). *Agraharam* therefore does not in fact disclose the recited limitations of clause c, not would it be obvious to modify *Agraharam* to meet the limitations of clause c: again, all *Agraharam* needs to create an alias email address is telephone number and primary email address (column 5 lines 49-52, column 3 lines 35-41). Why would *Agraharam* instead wait to generate an alias email address for an individual only once a family name *and* either (a) a postal address locator code (e.g., a zip code) or (b) a region specific portion of a telephone number (e.g., a telephone area code) is collected for an individual?

The Office Action appears to assert (at ***page 9***) that the sole difference between the invention of claim 1 (and claims 7 and 23, see Office Action ***page 11***) is that *Agraharam* does not disclose a trigger to generate the email address, relying on "Official Notice" to state that such a trigger would be obvious. However, a review of the references cited in support of the "Official Notice" appears to indicate that the inventions therein either (1) simply already have a database which includes email addresses, and they generate an email to a recipient at the email address upon occurrence of some

event, or (2) generate an email address in the same manner as *Agraharam*, in that once they have some type of data – like *Agraharam*'s telephone number – they generate an email address therefrom. The Applicant does not dispute that the prior art discloses construction of email addresses "triggered" by a certain event; *Agraharam* itself does so, as it constructs its alias email address once a telephone number and primary email address is entered by a registered user (column 5 lines 49-52, column 3 lines 35-41). *However, as discussed above, the prior art does not disclose – and it is not seen to be obvious – to collect name and location data for inclusion in a database, and then trigger generation of a standardized email address for inclusion in the database only when the collected data includes a family name and either (a) a postal address locator code (e.g., a zip code) or (b) a region specific portion of a telephone number (e.g., a telephone area code).* Further, as discussed above, the prior art does not disclose generation of a standardized email address having the same content/elements as those claimed. If the Office nevertheless believes *Agraharam* or another reference of record to disclose these features, kindly identify *with particularity* the location and content of the alleged disclosure or suggestion so that the Applicant may better respond.[1] Again, with respect, the citation of extended passages of text from prior art is not helpful, as opposed to citations which particularly identify the features in question. This is particularly true insofar as many of the citations seem inaccurate, in that the text being cited does not in fact disclose what the Office Action alleges that it discloses. The issues in this application will be more rapidly resolved if the differences between the claimed invention and prior art are clearly and accurately identified for the record.

6.b. Determination of Unobviousness

As noted in the foregoing *Examination Guidelines for Determining Obviousness Under 35 U.S.C. 103 in View of the Supreme Court Decision in KSR International Co. v. Teleflex Inc.*, once the Graham factual inquiries are resolved – such as the differences between the claimed invention

[1] See 37 CFR §1.104(c)(2): "When a reference is complex or shows or describes inventions other than that claimed by the applicant, the particular part relied on *must be designated as nearly as practicable*. The pertinence of each reference, if not apparent, must be clearly explained and each rejected claim specified."

and the prior art (as discussed in the foregoing Section 6.a of this Response) – Office personnel must determine whether the claimed invention would have been obvious to one of ordinary skill in the art. At page 57528, it is stated that "Office personnel must explain why the difference(s) between the prior art and the claimed invention would have been obvious to one of ordinary skill in the art," and it is further stated at pages 57528-57529 that:

> The key to supporting any rejection under 35 U.S.C. 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. The Supreme Court in KSR noted that the analysis supporting a rejection under 35 U.S.C. 103 should be made explicit. The Court quoting *In re Kahn* stated that "'[R]ejections on obviousness cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.'"

We submit that the claimed invention – which in accordance with §103 must be considered *as a whole*, and *at the time the invention was made* (i.e., without hindsight) – is not obvious to an ordinary artisan. As noted above, the claimed invention collects name and location data and creates an at least partial entry in the database, and only creates an email address once sufficient name and location data are found – once the name data includes a family name (surname), and once the location data includes one or more of a country specific postal address locator code (e.g., a zip code) and/or a region specific portion of a telephone number (e.g., an area code). The prior art does not create any such "partial entry" database, and one of ordinary skill would not think to construct such a database because it would be expected to contain numerous partial entries (which therefore do not include standardized email addresses) – which are effectively unusable, since they do not include standardized email addresses – rather than "complete" entries (those which include a family name and a postal address locator code and/or a region specific telephone code, and which therefore include a generated standardized email address). *If the objective of the invention is to generate a database of standardized email addresses, what is the use of collecting partial entries which include no standardized email addresses, and including these in the database?* Thus, the prior art does not take this approach, and like *Agraharam* (and some of the other references noted at page 9 of the Office Action), it only adds an entry to a database once it has the *complete* information needed to construct an email address (and the database entry then includes the constructed email address).

Alternatively, like some of the other references noted at page 9 of the Office Action, email addresses are not constructed at all, and rather a database is simply collected of email addresses, names, addresses, etc., and one can then reference the database entries to contact an individual via any of email, phone, mail, etc.

Claims 7 and 23 have also been amended to specifically recite that the generated standardized email address includes at least the family name of the individual. While email addresses often include last names (as acknowledged, for example, by *Agraharam* at column 1 lines 22-23), we submit that *in the context of the invention as a whole* (as required by §103), this feature is also unobvious over *Agraharam*: if one wishes to construct a system whereby an individual can be easily reached by email without knowledge of their true/primary email address, use of a telephone number (as in *Agraharam*) is logical. However, inclusion of a family name (surname) is not: if the surname is not a common one (and they often are not), they are easily misspelled, which would thwart delivery of the email. Thus, note that *Agraharam* only suggests use of first names in an email address (column 5 lines 24-37), and even then only where multiple people having the same family name share the same telephone number. When it is considered that *Agraharam* is intended to provide a way for a sender who only knows a recipient's telephone number (and first name) to compose an email address for the recipient, why would one incorporate the email address features of claims 7 and 23, which would only increase the amount of information that a sender needs to know in order to send an email, and which would also increase the risk of error (in case a sender did not accurately know family name and one or more of zip code and area code)?

7. **Section 18 of the Office Action: Rejection of Dependent Claims 4 and 10 under 35 USC §103(a) in view of U.S. Patent 5,987,508 to *Agraharam et al.***

Agraharam also does not disclose or suggest the invention of dependent claims 4 and 10, which recite that the standardized email addresses are automatically created without individuals' need to provide name and location data. In contrast, *Agraharam* requires that a user *must* register with the provider of the service, including providing his/her actual/primary email address and

telephone number (see column 3 lines 35-41, column 5 lines 49-52), before an alias email address can be generated.

The Office Action cites column 5 lines 24-58 as allegedly disclosing this feature, but again the citation seems overbroad and incorrect:

- Column 5 lines 24-37 note that since multiple people may share the same telephone number, multiple recipients may register with the same telephone number (and with different primary email addresses). In this case, so that emails sent to an alias email address are sent to the correct recipient at his/her correct primary email address, a name may be added to the alias email addresses (such as 2015558765.steve@email.att.net) so that the alias email is directed to the desired individual at his/her correct primary email address.
- Column 5 lines 38-58 then state *exactly the contrary of the claimed matter: this section clearly states that a user must register, and provide his/her actual/primary email address and telephone number, before an alias email address can be generated.* See particularly column 5 lines 49-52.

Again, if it is believed that *Agraharam* or another reference of record discloses the features of claims 4 and 10, kindly identify *with particularity* the location and content of the alleged disclosure or suggestion so that the Applicant may better respond. *Agraharam is simply not seen to disclose the matter the Office Action alleges it discloses.*

8. Section 20 of the Office Action: Rejection of Dependent Claims 6, 12, 16, and 20 under 35 USC §103(a) in view of U.S. Patent 5,987,508 to *Agraharam et al.*

The Office Action alleges that it would be obvious to attach a unique numeric identifier to an *Agraharam* email. However, *this does not make sense*. Agraharam seeks to provide a solution to *unknown* email addresses by allowing senders to send emails to alias addresses based on the recipients' phone numbers (which the senders *do* know). *If a unique numeric identifier was added to such alias addresses, senders would not know the numeric identifiers and would not know how to compose the alias addresses, and the invention would not function for its intended purpose.*

Further consider that since *Agraharam*'s alias email addresses are based on telephone numbers, *all* alias email addresses will be unique except where multiple recipients share the same telephone number – and *Agraharam* addresses this by appending the first names of the recipients, rather than adding any numeric code (see column 5 lines 24-37). A sender would naturally know the first name of the recipient that he/she seeks to email, and thus appending a first name to the *Agraharam* email is not problematic. In contrast, unlike a telephone number or first name for a recipient, a sender would not know any unique numeric identifier assigned to a recipient, and would therefore not be able to readily email a recipient as *Agraharam* intends. Thus, we submit that claims 6, 12, 16, and 20 are novel and unobvious. If it is asserted otherwise, please explain: if a unique numeric identifier was attached to *Agraharam*'s telephone number-based email addresses, how would a sender who seeks to email the recipient, and who knows no more than the recipient's telephone number (and/or the recipient's name), be able to guess the numeric identifier and email the recipient?

Please note that this question and others were posed in the last Response, but the Office Action does not offer a reply. Kindly provide a reply in any subsequent Office Action. See MPEP 707.07(f), Answer All Material Traversed ("Where the applicant traverses any rejection, the examiner should, if he or she repeats the rejection, take note of the applicant's argument and answer the substance of it"); also see Examiner Notes for PTO form paragraphs 7.37 and 7.38 (as reproduced in MPEP 707.07), which require that all relevant arguments by the Applicant be addressed.

9. Remaining Claims / Rejections

The remaining claims are submitted to be allowable for at least the same reasons as claims 1, 7, and 23, from which all remaining claims depend.

10. In Closing

If any questions regarding the application arise, please contact the undersigned attorney. Telephone calls related to this application are welcomed and encouraged. The Commissioner is authorized to charge any fees or credit any overpayments relating to this application to deposit account number 18-2055.

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